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REMARKS

Applicant notes with appreciation withdrawal of the final Office Action dated June 15, 2006, and entry of the proposed amendment. In response to the final Office Action dated August 30, 2006, Applicant presents the following remarks again traversing the outstanding rejections. In light of these remarks, favorable reconsideration of all claims is respectfully requested.

Firstly, Applicant again submits that the issuance of a final Office Action is improper and unwarranted. Applicant attacked the examiner's rejections as flawed, including the lack of any substantive basis for rejecting claim 36 since the prior art does not in any way disclose a rigid fiber tissue or mat in the claimed combination. In the most recent Action, the examiner finally rejects claim 36 as anticipated, but does not in any way contend that a single prior art reference discloses each and every element of the claim (which of course is a prerequisite for a proper anticipation rejection). Indeed, claim 36 is not even mentioned anywhere in the statement of rejection! This is reversible error, and contravenes the strictures of the Manual of Patent Examining Procedure. *See, e.g.*, MPEP Section 707.07(b) ("Where a claim is refused for any reason relating to the merits thereof it should be rejected and the ground of rejection fully and clearly stated") (emphasis added). Accordingly, the examiner should withdraw the finality of the Office Action and issue a non-final Action either allowing claim 36 or providing Applicant an opportunity to respond to a proper basis for the rejection and set a record for purposes of appeal.

The final Action also maintains the rejection of claim 1 because it allegedly violates the strictures of Section 112, first paragraph. The genesis for this rejection is that there is allegedly no "expressed or implied" support for the limitation that the thermoplastic polymer coating is "free of random discontinuities." As Applicant pointed out several times in previous responses, U.S. Patent law does not in any way mandate "expressed support" for a limitation in the specification. Rather, it is sufficient if the originally filed disclosure would have conveyed to one having ordinary skill in the art that the inventor

had possession of the concept of what is claimed.¹ Full support for the "negative" limitations in claim 1 may be found in paragraph 6 of the published application, as well as in the drawing figures (see, e.g., Figure 2 illustrating the continuous, uninterrupted coating 54 free from random discontinuities covering the non-woven fiber tissue or mat 52 to thereby significantly reduce the porosity of the wall covering). Since the drawings undoubtedly form part of the written description, "expressed support" for the limitation at issue is thus provided.

Despite acknowledging that Figure 2 illustrates a layer of thermoplastic polymer 54, that is undoubtedly continuous and uninterrupted, the examiner again contends that "the reference" (presumably, Applicant's specification) "does not teach what are 'random discontinuities' as to provide support for the now claimed continuous coating being free of 'random discontinuities.'" The examiner essentially requires the Applicant to prove a "negative" by showing where an intentionally omitted structure (random discontinuities) is described in Applicant's specification or shown in the drawings. Simply put, the polymer layer 54 at issue is "free" of random discontinuities, as illustrated, which is all that claim 1 requires.

In maintaining the rejection, an attempt is made to characterize the decision of *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973) cited by the Applicant as inapposite. However, the examiner completely mischaracterizes the holding of this case and, in doing so, provides an unduly narrow interpretation of the law as it regards new matter. Specifically, the examiner contends that this case stands for the narrow proposition that the "rephrasing of a passage does not constitute new matter." Applicant fully agrees with this statement of the law. However, the actual holding in this case is that a term appearing nowhere in the specification can be added to a claim without constituting new matter as long as the concept of what is being claimed is present in the original disclosure. Here, this standard is clearly met, since as Applicant points out and the examiner does not contest,

¹ *In re Anderson*, 471 F.2d 1237, 176 USPQ 331(CCPA1973).

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the polymer layer 54 shown in the drawings is continuous and thus "free of random discontinuities."

The Action further contends that claim 1 runs afoul of Section 112, first paragraph, because the limitation requiring that the "porosity of the wall covering is reduced significantly" by the polymer coating is allegedly indefinite. This indefiniteness results from the alleged fact that "the claim is NOT comparing to what is the reduced porosity compared to . . . is Applicant trying to refer to a reduction of the porosity of the non-woven fiber tissue or mat instead?"

As Applicant emphasized in the prior responses, this statement apparently disregards the fact that claim 1 expressly requires that the porosity of the overall wall covering is reduced by the polymer coating covering the non-woven fiber tissue or mat. No reasonable interpretation of the claim or reading of the language would cause a skilled artisan to query whether it is the wall covering or the fiber tissue or mat that has reduced porosity. Indeed, the examiner's interpretation is strained, since the porosity of the fiber tissue or mat itself remains unchanged as a result of the polymer covering, even though the porosity of the overall wall covering is understandably reduced by the addition of a layer. Since the language used is perfectly clear and would be easily understood by a skilled artisan, it is believed that the claim is definite and the rejection unfounded.

The final rejection also seems to suggest that the claim must include a "parameter" that would "allow one of ordinary skill in the art to determine what is the porosity of the claimed material" in order to render the "reduced porosity" limitation definite. Such a requirement is plainly not in accordance with the Manual of Patent Examining Procedure, which explains that "[t]he fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite." MPEP § 2173.05(b). Here, a skilled artisan would easily understand from the claim language that the porosity of the wall covering is reduced by the addition of the polymer layer without the identification of any parameter. *See, e.g.*, the Jackson patent, which in claim 1 recites a "coating being applied at a thickness which is sufficiently low to cause formation of miniature

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discontinuities . . ." (emphasis added). Accordingly, the addition of some precise amount of the reduction achieved, as the examiner seems to think is required, is unnecessary and would unduly narrow the Applicant's claim.

In support of this rejection, the examiner also cited several decisions as standing for the proposition that "[i]t is necessary that the product be described with sufficient particularity that it can be identified so that one can determine what will and will not infringe." Aside from being non-precedential, the first decision cited, *Benger Labs, Ltd. v. R.K. Larsen Co.*, 135 USPQ 11 (E.D. Pa. 1962) merely stands for the proposition that a patent is not invalid for failing to identify the "precise chemical structure of the claimed product." Hence, it hardly supports the examiner's requirement for more specificity, since its holding is directly the opposite (that is, less specificity is fine in the claims). Also, it deals exclusively with claims to compositions of matter, rather than product claims.

The second decision cited, *In re Bridgeford*, 149 USPQ 55 (CCPA 1966), dealt exclusively with "product-by-process" claims. Thus, it is not on point, either.

Aside from also being non-precedential, the third decision cited, *Locklin v. Switzer Bros, Inc.*, 131 USPQ 294 (9th Cir. 1961), actually supports the Applicant's position. There, the claim required "sufficient melamine" to render a resin "substantially insoluble." *Id.* at 299. The court held that "the fact that the limits of melamine are . . . stated in functional language does not render the patent invalid." *Id.* Thus, quite contrary to the present examiner's position, specifying a particular parameter or the precise amount of the product in the claim was simply not required in order to comply with Section 112, first paragraph.

Even assuming the law of these cases is as stated by the examiner, no substantial, objective evidence cited establishes that there has been a violation of Section 112, first paragraph here. Rather, the examiner merely states her opinion that claim 1 is deficient, without even giving a reason as to why a skilled artisan would be unable to ascertain the claim scope. Indeed, Applicant submits that the change suggested by the examiner to include "language that indicates that the porosity of the wall covering is reduced by comparison to a wall covering without the polymer coating" is not necessary, since this

meaning would be clear to a skilled artisan reviewing the present specification, even if such is not expressly set forth in the claims (*see, e.g.*, para. 6 of Applicant's published specification, which explains that "The polymeric coating is a thermoplastic material that covers the surface of the glass fiber tissue, thereby reducing porosity significantly.").

Moving on to the final rejection of claim 1 based on Jackson, the examiner still disregards Applicant's amendment to require that the claimed coating (not just the surface) is free of random discontinuities that, if otherwise present, would substantially increase porosity of the wall covering. In stark and total contrast, Jackson discloses a wall covering having a "porous polymeric ply . . . fused to and supported by a nonwoven substrate ply" (*emphasis added*). At column 3, lines 51-55, Jackson expressly defines "porous" and "continuous" synonymously as referring to "the existence of a multitude of small holes, openings or gaps in the polymeric ply of the wallcovering," not just its surface. Noteworthy is the fact that Jackson, choosing to be his own lexicographer, selected a definition of the word "continuous" that does not comport with the ordinary meaning of "uninterrupted."²

Jackson thus does not disclose, teach or otherwise suggest a coating that covers the non-woven mat in a continuous fashion (giving "continuous" its ordinary meaning) and free of random discontinuities, as shown in Applicant's Figure 2. Quite the contrary, this reference actually teaches away from such an arrangement by virtue of the critical need for holes in the outer ply of the wall covering (see, e.g., col. 5, lines 45-51, "The key feature of the coating or plastisol application process is that the plastisol is applied very thinly to the nonwoven substrate ply . . . [which] results in small discontinuities, holes, or gaps, which upon fusion form miniature holes or pores in the fused polymeric ply" (*emphasis added*)). Jackson is also completely silent as to whether the polymeric ply covers the nonwoven substrate in a manner that would in any way facilitate painting (not printing),

² *Intellicall, Inc., v. Phonometrics, Inc.*, 952 F.2d 1384, 1388, 21 USPQ2d 1383, 1386 (Fed. Cir. 1992) ("An inventor may "be his own lexicographer and . . . give terms uncommon meanings."), but cf. *Jonsson v. Stanley Works*, 903 F.2d 812, 820, 14 USPQ2d 1863, 1871 (Fed. Cir. 1990) ("[w]ords in a claim . . . [are] given their ordinary and accustomed meaning.")

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including by way of a roller. Accordingly, claim 1 as amended is believed to distinguish over Jackson, and reconsideration is respectfully requested.

The instant final Action also maintains the rejections of claims 23-35 based primarily on Jackson "as further evidenced by" the Abstract of WO 95/07946. Reconsideration of these rejections is respectfully requested, since neither reference discloses, teaches, or suggests the invention of claim 23 as a whole, including a layer of paint roller-applied to a thermoplastic polymer coating applied to a non-woven fiber tissue or mat. Since this express element of claim 23 is completely disregarded in the formulation of the rejection, favorable reconsideration of this claim and its progeny is requested.

Despite including all limitations of an allowable base claim, the independent patentability of several of the claims depending from claim 23 over Jackson and the other cited references is also re-emphasized. For example, claims 28 and 29 require a mineral filler to form a non-smooth outer surface. These claims stand rejected based on the combination of Jackson in view of Ishii et al. (which is again never discussed in the rejection) and Penz et al. Again, the only reason Penz et al. is cited is for its disclosure of a glass mat reinforced thermoplastic suitable for the production of paintable parts comprising a thermoplastic matrix polymer, one or more glass mats, and a fine-particle mineral fiber. The primary contention made in support of the rejection is that "[s]ince both Jackson et al and Penz et al. are from the same field of endeavor, the purpose disclosed by Penz et al. would have been recognized in the pertinent art of Jackson et al."

Applicant respectfully requests reconsideration on the ground that a skilled artisan would not combine Jackson and Penz et al. to arrive at the present invention simply because they are "from the same field of endeavor" or that the "purpose" of one would have been recognized in the "pertinent art" of the other. Specifically, one of ordinary skill in the art would not use the teaching of Penz et al. to include a mineral filler in the chemical composition of the polymeric coating to create a non-smooth surface in combination with Jackson, when in fact Jackson expressly teaches that such a feature is not a desirable attribute of a wall covering (see, e.g., col. 2, lines 5-12). Indeed, Jackson extols the

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desirability of providing a wall covering with a smooth outer surface (see Abstract, line 1), and simply does not contemplate in any way imparting a mineral filler to create a non-smooth outer surface to facilitate roller painting. Incredibly, the Examiner ignores this express teaching and instead contends that both Jackson and Penz et al. "avoid having 'smooth' surfaces," which is simply not true.

When properly interpreted, Jackson thus actually teaches away from the claimed invention, and otherwise fails to motivate a skilled artisan to combine the teachings of Penz et al. to provide a wall covering with a non-smooth outer surface formed using a mineral filler. As observed by the Court of Appeals for the Federal Circuit, "[e]lements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents."³

The examiner in the final Office Action indicates that she "reviewed the cited passage" of Jackson at col. 2, lines 5-12 "and finds no correlation to applicant's conclusion of teaching away." The cited passage specifically disparages a prior art acoustic lamina because it has a "rough textured surface." Contrasting this prior art, the next sentence then states that "there exist[s] a need for a . . . wallcovering having a relatively higher permeability, yet which has a smooth outer exposed surface." Applicant thus submits that there is a clear factual predicate for a "teaching away" of surface roughening a wall covering of the type claimed by including mineral fillers of Penz et al. *See, e.g. In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130 (Fed. Cir. 1994) ("A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."). By disregarding this teaching, the examiner simply refuses to consider Jackson "as a whole," as is required by numerous precedential decisions.

As for reliance on Ishii et al. in the final rejection of claims 10, 13, 32, 35, and 38-39,

³ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

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and despite Applicant's protestations, absolutely no reason is provided in the final Office Action to explain why a skilled artisan would combine the teachings of this reference with those of Jackson to arrive at the claimed invention. Rather, as in the prior actions, the examiner simply selects bits and pieces of the prior art teachings as necessary to meet the terms of Applicant's claimed invention. Such a hindsight approach using Applicant's specification and claims as a blueprint has long been assailed.⁴ Absent such a motivation or suggestion in the prior art, the rejections relying on Ishii et al. cannot stand and should be withdrawn.

As noted in the prior response, dependent claim 35 also requires that the polymeric material comprises approximately a 45/5/50 by weight mixture of high-density polyethylene, titanium dioxide, and a dispersion, said dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene. The primary reference to Jackson specifically requires a plastisol as a component of the polymer coating, which by definition includes a plasticizer. Such is clearly excluded by the plain terms of claim 35, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Given that the examiner has apparently abandoned her previous position regarding this claim, and fails to identify the limitations of the claim in any of the prior art references, reconsideration of the final rejection is respectfully requested.

With specific regard to claim 39, the examiner still contends that Jackson "discloses the claimed invention except that it teaches the use of titanium oxide instead of titanium dioxide." Again, this is simply not true, since Jackson fails to disclose, teach, or suggest in any way a mixture of high-density polyethylene or a dispersion comprising ground calcium carbonate and ground titanium dioxide in high density polyethylene (all of which form part of the "claimed invention"). The examiner does not contest Applicant's argument, but instead cites to Ishii et al. as disclosing that titanium dioxide is an equivalent of titanium oxide. Regardless of whether Ishii et al. discloses titanium dioxide, and assuming

⁴ *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), citing *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

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for the sake of argument that the references are properly combinable, this secondary reference does not otherwise supply the teaching missing from Jackson necessary to render the invention of claim 39 obvious. Accordingly, since the cited combination of references fail to teach every limitation of the claim at issue, a *prima facie* case of obviousness is lacking. Reconsideration is therefore respectfully requested.

Although believed to be allowable as dependent on an allowable base claim, the independent patentability of several of the claims depending from improperly rejected claim 36 is also again emphasized. For instance, dependent claim 2 requires that the outer surface of the polymer coating has a surface tension of at least approximately 30 dynes/cm. In the Office Action, it is acknowledged that Jackson is completely silent as to the claimed surface tension, and no other reference is cited as allegedly supplying this missing teaching. However, the examiner somehow concludes that such a surface tension would be "inherent to the product of the prior art as it meets all the structural limitations of the present invention."

First of all, the product of the prior art does not meet "all the structural limitations of the present invention." For one, the prior art product does not include the claimed surface tension. In this regard, it is noteworthy that any contention that the claimed surface tension is a "process step," rather than a structural limitation of the claim, has been withdrawn in the face of Applicant's arguments.

Secondly, the basis for the rejection is contrary not only to the Manual of Patent Examining Procedure, but also precedential decisions holding that "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."⁵ Not only do the steps described for forming the Applicant's claimed wall covering differ completely from those outlined in Jackson, but Applicant's processing involves a treatment designed to impart a particular surface tension in order to facilitate roller painting. As acknowledged in the record, Jackson fails to mention the surface

⁵ See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) and Section 2112, MPEP generally.

tension of the substrate or any steps taken to alter it, so it cannot possibly anticipate the invention of dependent claim 2.

In the alternative, the examiner asserts that the "presently claimed function of surface tension . . . would have obviously been provided as a result of the product of" Jackson, apparently relying on a theory of "obviousness by inherency." However, "[t]hat which may be inherent is not necessarily known" and "[o]bviousness cannot be predicated on what is unknown."⁶ Moreover, "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection."⁷ Since Jackson nowhere contemplates, teaches, suggests, or even discusses surface tension to improve the roller paintability of a wall covering, it standing alone cannot possibly make it known to provide a surface tension within the claimed range.

In an effort to refute Applicant's position, the examiner cites to *In re Skoner*, 186 USPQ 80 (CCPA 1975) for the proposition that "reliance on inherency is not improper even though [sic a] rejection is based on Section 103 instead of Section 102." While that is no doubt the holding of that case, it resulted from a much different factual situation than the one confronting the examiner. In *Skoner*, the claim at issue covered wire brushing to a certain extent to produce a certain surface condition. The prior art reference taught wire brushing generally, but not to the extent required to produce what was claimed. Understandably, the Board was willing to find that wire brushing to the extent claimed was inherent in the reference, given that wire brushing was generally disclosed.

In stark and total contrast, nothing in Jackson even remotely mentions enhancing surface tension using any process, let alone surface tension in general. Thus, it simply cannot be the case that the value suggested by the Applicant as creating advantageous surface characteristics for purposes of roller painting are "inherent" in Jackson. Thus, *Skoner* is inapposite and does not support the examiner's position.

⁶ *In re Spormann*, 363 F.2d 444, 448, 150 USPQ 449, 452 (CCPA 1966).

⁷ *In re Newell*, 891 F.2d 899, 901, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Looking at the situation from a different perspective, Jackson does not "enable" a skilled artisan to make a wall covering having the claimed surface tension. There can be no doubt that Jackson does not describe Applicant's claimed invention sufficient to place it in possession of a person of ordinary skill in the art, when in fact the particular surface tension claimed by the Applicant is not even remotely mentioned.

Despite being rejected based on the combination of Jackson and Ishii et al. alone, claim 13 is also rejected based on this combination in further view of Melber et al. Again, the primary reference to Jackson specifically requires a plastisol as a component of the polymer coating. By definition, a plastisol includes a plasticizer. Such an added component is clearly excluded by the plain terms of claim 13, which does not recite a plasticizer as a part of the 100 weight percent of the polymeric material. Nothing in Melber et al. supplies the teaching missing from Jackson that would render the claimed composition unpatentable; namely, elimination of the plasticizer. Thus, the combination of references simply cannot teach the invention of claim 13.

Claim 40 requires a thermoplastic polymer with a mineral filler forming a visible outer, non-smooth roller paintable surface of a wall covering with a non-woven tissue or mat having a visible inside surface as well. As noted above, Jackson specifically extols a smooth outer surface, and concomitantly disparages a non-smooth outer surface. *See* col. 2, lines 5-16. Despite the contrary admission by the examiner that Jackson teaches a smooth surface, this claim requiring the exact opposite structure as that taught in the prior art reference cited is still rejected as being anticipated. For the second time, Applicant respectfully requests that the examiner reconsider the rejection and either supply the requisite substantial evidence for rejecting the claim, or else withdraw the rejection as unfounded.

In view of the foregoing remarks, Applicant submits that claims 1-13 and 22-40 are allowable over the cited prior art and respectfully requests favorable reconsideration. In the event the Examiner agrees, Applicant will also submit the information necessary to address the Section 112 rejection made with respect to dependent claims 8 and 30. In the

meantime, the Examiner is invited to telephone the Applicant's undersigned attorney at the number listed below if any unresolved matters remain, and may debit any fees due from Deposit Account 50-0568.

Respectfully submitted,

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